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In re Application of
DOMAZAKIS, Emmanouil :
Application No.: 10/577,812 :
PCT No.: PCT/GB04/00050 :
Int. Filing Date: 18 October 2004 :
Priority Date: 17 October 2003 :
Attorney Docket No.: CFAV5 :
For: METHOD FOR THE PREPARATION OF
PREPARATION OF PREPARATION OF
FERMENTED DRY OR SEMI-DRIED
MEAT PRODUCTS, WITH PARTIAL
SUBSTITUTION OF THE ANIMAL FAT
AND DIRECT INCORPORATION OF
OLIVE OIL

DECISION ON PETITION
&
NOTIFICATION OF
ABANDONMENT

This **amended**¹ decision is issued in response to applicant's "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unavoidably under 37 CFR 1.137(a)" filed 28 April 2006.

BACKGROUND

On 18 October 2004, applicant filed international application PCT/GB04/00050 which claimed a priority date of 17 October 2003. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 21 April 2005. Pursuant to 37 CFR 1.495, the thirty-month time period for submitting the requisite basic national fee in the United States of America was to expire 30 months from the priority date, 17 April 2006.

On 28 April 2006, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied, *inter alia*: by a copy of the international application; an executed declaration; a preliminary amendment; and a petition under 37 CFR 1.137(a) accompanied by the requisite \$250 petition fee.

¹The Decision on Petition dated 24 May 2006 improperly treated the "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unavoidably under 37 CFR 1.137(a)" filed 28 April 2006 under 37 CFR 1.137(b), not 37 CFR 1.137(a). Therefore, the "Decision on Petition" dated 24 May 2006 is hereby **VACATED**.

On 24 May 2006, the Office of PCT Legal Administration mailed a "Decision on Petition" indicating that the petition under 37 CFR 1.137(b) was granted.

DISCUSSION

A. Petition under 37 CFR 1.137(a)

The above-identified application was abandoned on 18 April 2006 for failure to pay the basic national fee 30 months from the priority date for international application no. PCT/GB04/00050.

Applicant states that the delay in payment of the basic national fee was unavoidable. A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the requisite petition fee; (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 1.20(d)) required pursuant to 37 CFR 1.137(c). Applicant has satisfied Item (1), (2) and (4).

Pursuant to 37 CFR 1.137(a), an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887). However, the showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Here, counsel's statement fails to provide sufficient evidence to show that all action necessary were taken to pay the basic national fee by 17 April 2006. Applicants states that a violent storm resulted in counsel missing the April 17, 2006 deadline, but counsel fails to provide sufficient evidence to establish that the basic national could not have been paid within the two week period following the storm and prior to the date the fee was due (i.e. 17 April 2006). It appears, for example, that counsel could have contacted applicants and/or the previous law firm to identify existing patent application for which responses were due and to advise applicants that the firm was not able to keep tract of impending due dates and that the applicant should take action accordingly. Further, counsel indicates that the abandonment resulted from the failure to docket the national stage deadline date. But counsel has not adequately explained why docketing of the 30 month date did not occur prior to two weeks before this deadline. The 30 month deadline is known, or should have been known by applicant and counsel, at the time of filing the international application. Docketing this deadline date in the final two weeks, or apparently contemplated by counsel, does not suggest that this matter was given the degree of care that applicants would give their "most important business." Finally, counsel indicates the "general inaccessibility" to the firm offices but does not indicate that the office was inaccessible for the purpose of acquiring important, time sensitive client information.

In summary, the actions taken in the prosecution of this case do not reflect unavoidable delay. Specifically, unavoidable delay is present only where petitioner and

those acting for petitioner take all actions necessary to continue the prosecution of an application, but through the intervention of unforeseen circumstances, a required action is not timely taken. The actions and circumstances described in this petition do not reflect the "care or diligence that is generally used and observed by prudent and careful men in relation to their most important business." Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Since applicant has not met the requirements for revival of an application under 37 CFR 1.137(a), revival under this section would not be proper.

B. Declaration of Inventorship

The previous Decision on Petition, dated 28 April 2006, indicated that the "Declaration for Utility or Design Patent Application" (Form PTO/SB/01) submitted on 28 April 2006 was not in compliance with 37 CFR 1.497(a)(3) and 37 CFR 1.63(c)(1). However, a review of the application reveals that a declaration of inventorship under PCT Rule 4.17(iv) and 51bis.1(a)(iv), filed with the international application, complies with 37 CFR 1.497(a)-(b). Therefore, a newly executed declaration is not required.

CONCLUSION

The petition under 37 CFR 1.137(a) is DISMISSED without prejudice and the application is ABANDONED.

The "Decision on Petition" dated 28 April 2006 reviving the above-identified application is hereby VACATED.

Applicants may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(b) requesting that the application be revived. Any petition filed under 37 CFR 1.137(b) requesting that the application be revived must meet the criteria indicated in 37 CFR 1.137. This recommendation to file a petition under 37 CFR 1.137(b) should not be construed as an indication as to whether or not any such petition(s) will be favorably considered.

If reconsideration on the merits of this petition is desired, an appropriate response to this decision must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." Extensions of time may be obtained under 37 CFR 1.136(a).



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